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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,195	06/27/2002	Henri Samain	13833.0013	5156

7590 10/03/2004  
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Stepto & Johnson  
1330 Connecticut Avenue N W  
Washington, DC 20036

**RECEIVED**

OCT 06 2004

STEPTOE &amp; JOHNSON, LLP

EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 10/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Date: 11/3/05  
Action Due: Response Due

**Office Action Summary**

Application No.

10/089,195

Applicant(s)

SAMAIN ET AL.

Examiner

Margaret G. Moore

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12 to 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 to 17, 19 to 23 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12 - 17 and 19 - 23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Liebeskind et al.

Initially the Examiner would like to note that a prior art composition need not specifically be referred to as a cosmetic composition to meet and/or render obvious the instant claims since this phrase amounts to a future intended use limitation and the claimed composition is fully defined by the components described therein. Even so, note that column 33, line 31, teaches that the composition in Liebeskind et al. can be used in cosmetic compositions, lotions, creams and ointments.

Liebeskind et al. teach a silane having improved water solubility. Particular attention is drawn to formula (VIII). This silane contains an amino cationic group, which meets the required group with a cosmetic effect as well as the particular limitations of claims 14 and 20. In this silane, "m" is an integer of from 1 to 3. The specifically delineated value of "1" anticipates a silane having one R<sub>22</sub> group, which is attached to the Si atom through a Si-C bond (i.e. is non-hydrolyzable). The R<sub>22</sub> group is defined as either R or OR<sub>33</sub>, a polyether group. Such a group meets the requirement of a non-hydrolyzable group with a solubilizing function.

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Thus in view of the limited choice of selections required, i.e. selecting an "m" group of 1 (one of three options, wherein "1" is clearly taught by Liebeskind et al.) and selecting an OR<sub>33</sub> group (one of two options) one having ordinary skill in the art would have immediately envisioned a silane having 1 "m" unit and having an OR<sub>33</sub> group and in such a manner claim 12 is anticipated by the prior art.

On the other hand, one having ordinary skill in the art would have found the selection an appropriate "m" value and R<sub>22</sub> group to have been obvious over the choices provided by Liebeskind et al. as such one having ordinary skill in the art would have found the instant claims to have been obvious.

Column 35, line 39, teaches an amount of .1 to 1% volume silane, while column 36, line 2, teaches an amount of 10% or more by volume silane. Such compositions will meet the weight requirements in claims 12 and 13.

In claim 12 the hydrolysable groups are present in the alternative with hydroxyl groups and since Liebeskind et al. teach hydroxyl groups, this meets the requirement of claim 16. Similarly note that claims 19 and 21 are met by Liebeskind et al. since these groups are not required to be present.

The limitations of claims 22 and 23 fail to lend any patentable distinction to the instant claims since "in the form of a hair product" does not impose any type of limitation or requirement on the composition beyond a future intended use; they do not require any additional ingredients be present other than those specifically found in claim 12.

On the other hand, since patentees teach that the composition therein can be used as a cosmetic, lotion, cream or ointment, one having ordinary skill in the art would have been motivated to include the silane compound of Liebeskind et al. in a hair product in an effort to obtain the known benefits and properties thereof.

Finally, regarding claim 15, the Examiner notes that the term "cosmetic effect" is quite broad. Patentees teach and/or suggest a silane composition having an Si bonded nonhydrolyzable amine group. In order to anticipate and/or suggest the limitation of claim 15, one would have to consider the polyether group attached to the silane to be a non-hydrolyzable group with a cosmetic effect. In view of the breadth given to the term "cosmetic effect" the Examiner is of the opinion that a polyether group can meet this

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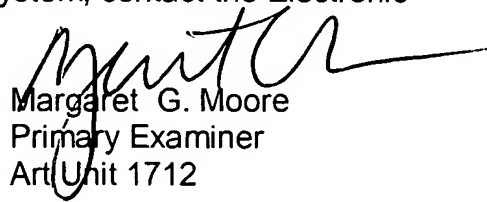
requirement. That is, polyether groups have surface active and lubricious properties that will remain on hair and thus have an effect on hair. In view of the fact that the Examiner must read the claims in their broadest possible light, claim 15 is anticipated and/or suggested by the prior art.

4. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest a silane compound having 2 silicon atoms having the required groups, hydrolysable and non-hydrolyzable, attached as claimed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
9/30/04